

REMARKS

Claims 1-72 are all of the claims pending in the application. Applicant thanks the Examiner for conducting an interview with the undersigned on February 19, 2008.

I. Advisory Action

In the Advisory Action dated December 27, 2007, the Examiner indicated that the Amendment filed on December 3, 2007, will be entered for purposes of appeal and has been considered but fails to place the application in condition for allowance.

The Examiner indicated that the reply has overcome the 35 U.S.C. § 101 rejection of claims 1-24 and the 35 U.S.C. § 112, first paragraph rejection of claims 1-48. Claims 49-72 remain rejected under 35 U.S.C. § 112, first paragraph, claims 1-72 remain rejected under 35 U.S.C. § 112, second paragraph, and claims 1-72 remain rejected under 35 U.S.C. § 103(a).

II. Claim Rejections under 35 U.S.C. § 112, First Paragraph

Claims 49-72 are rejected under 35 U.S.C. § 112, first paragraph. Claims 49-72 are hereby amended as discussed in the interview to recite, *inter alia*, “a computer storage medium.” Applicant respectfully submits that no new matter is added and that a computer storage medium is supported by the specification, as originally filed, for example, on page 40, lines 8-12. Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, first paragraph rejection of claims 49-72.

III. Claim Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-72 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1 and 2 are hereby amended, without narrowing, for purposes of clarity, as discussed in the interview. Applicant respectfully submits that claims 1-72 are definite and respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph rejection.

IV. Claim Rejections under 35 U.S.C. § 103(a)

AAPA and Harada

Claims 1-3, 5, 7-9, 11, 13-15, 17, 19-21, 23, 25-27, 29, 31-33, 35, 37-39, 41, 43-45, 47, 49-51, 53, 55-57, 59, 61-63, 65, 67-69 and 71 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's allegedly admitted prior art (JP Pub. No. 10-49493; hereinafter "AAPA") in view of Harada et al. (U.S. Patent No. 7,093,300; hereinafter "Harada"). Applicant respectfully traverses this rejection.

Applicant respectfully notes that the initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rikckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). In *KSR International Co. v. Teleflex Inc.*, the Supreme Court held that the prior art relied upon, or the knowledge generally available in the art at the time of the invention, must support some apparent reason as to why an artisan of ordinary skill would have found it obvious to modify a reference or to combine references, and this reason should be made explicit. 127 S. Ct. 1727 (U.S. 2007).

Further explaining this requirement, the *KSR* court held,

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. 127 S. Ct. at 1741.

The Examiner asserts that the motivation for combining AAPA and Harada would have been "to provide an electronic apparatus/method of canceling the inoperable state...caused to

prevent theft, can be canceled at minimal effort and cost,” as taught by Harada at col. 2, lines 5-21. But Harada already teaches an electronic apparatus having a security function, wherein, when the electronic apparatus falls into an inoperable state and cannot perform its intrinsic operation to attain security and prevent theft, the inoperable state can be canceled relatively easily (*see* col. 2, lines 6-11 of Harada). Thus, a person of ordinary skill in the art at the time of the invention clearly would not have found it necessary to combine AAPA and Harada in order “to provide an electronic apparatus/method of canceling the inoperable state...caused to prevent theft, can be canceled at minimal effort and cost.” Furthermore, the Examiner has failed to identify any reason as to why the teachings of AAPA would help “to provide an electronic apparatus/method of canceling the inoperable state...caused to prevent theft, can be canceled at minimal effort and cost.” Applicant respectfully submits that no such reason would have been apparent to a person of ordinary skill in the art at the time of the invention.

Accordingly, Applicant respectfully submits that an apparent reason to modify the references in the manner claimed by the Examiner is simply not present in the cited references, and thus the claims are not obvious over the cited combination of references.

Applicant further submits that the modifications described by the Examiner are not merely a simple substitution of elements with equivalent functions, nor are they a matter of routine design choice. Moreover, the Examiner has not offered any evidence showing that the claimed invention could simply be created by picking and choosing various elements from disparate references; the Examiner has not shown that this combination would be possible without a significant reengineering of the system.

Instead, the combination, rather than being obvious to a person of ordinary skill in the art at the time of the invention, is a product of improper hindsight. The *KSR* court warned that “[a]

factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” 127 S. Ct. at 1743. Applicant respectfully submits that the Examiner’s allegations that it would have been obvious to combine the references are a product of improper hindsight bias.

Accordingly, at least for the above reasons, Applicant respectfully submits that the Examiner has not shown *prima facie* obviousness and that it clearly would not have been obvious for a person of ordinary skill in the art to combine the references in order to arrive at the claimed invention.

Even if, *arguendo*, AAPA and Harada are combined, although Applicant maintains that the combination is improper, the combination does not teach or suggest all of the features recited in the claims. For example, independent claim 1 recites, *inter alia*,

a module for obtaining first device identification information from the first external device connected via the interface to the electric apparatus to identify the first external device;
a module for associating the function limit with the device identification information of the first external device to obtain a cryptographic key

The remaining independent claims recite features similar to, although not necessarily coextensive with, the above-mentioned features. The Examiner concedes that AAPA fails to teach a step for associating the function limit with the device identification information obtained at the first device identification information obtaining step to thereby obtain a cryptographic key (*see* page 7 of the Office Action dated September 4, 2007). The Examiner, however, alleges that Harada teaches this feature, pointing to col. 2, line 61-col. 3, line 10 of Harada. Applicant respectfully disagrees.

The Examiner interprets the output code A221 disclosed in Harada to be the same as the cryptographic key (*see* page 7 of the Office Action). But Applicant respectfully notes that output

code A221 is not obtained from an external device. Rather, output code A221 is obtained through a calculation involving A22, an individual code assigned to the electronic apparatus (*see* col. 2, lines 61-64), not to an external device. Moreover, Harada does not disclose associating the function limit with the device identification information of an external device.

Thus, regardless of whether or not the output code A221 is the same as the cryptographic key and whether or not the individual code A22 is the same as the device identification information, neither is obtained from an external device. Furthermore, neither AAPA nor Harada suggests associating the function limit with the device identification information of the first external device to obtain a cryptographic key.

Accordingly, at least for the above reasons, Applicant respectfully submits that claims 1-3, 5, 7-9, 11, 13-15, 17, 19-21, 23, 25-27, 29, 31-33, 35, 37-39, 41, 43-45, 47, 49-51, 53, 55-57, 59, 61-63, 65, 67-69 and 71 are patentable over AAPA and Harada.

AAPA, Harada, and Bajikar

Claims 4, 6, 12, 16, 18, 22, 24, 28, 30, 34, 36, 40, 42, 46, 48, 52, 54, 58, 60, 64, 66, 70 and 72 are rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Harada, and further in view of Bajikar (U.S. Pub. No. 2002/0194500; hereinafter Bajikar). Applicant respectfully traverses this rejection.

Applicant respectfully submits that claims 4, 6, 12, 16, 18, 22, 24, 28, 30, 34, 36, 40, 42, 46, 48, 52, 54, 58, 60, 64, 66, 70 and 72 are patentable over AAPA and Harada for at least the reasons discussed above with respect to claims 1-3, 5, 7-9, 11, 13-15, 17, 19-21, 23, 25-27, 29, 31-33, 35, 37-39, 41, 43-45, 47, 49-51, 53, 55-57, 59, 61-63, 65, 67-69 and 71. Furthermore, Applicant respectfully submits that Bajikar does not cure the above-discussed deficiencies of AAPA and Harada.

The Examiner asserts that the motivation for combining AAPA and Harada with Bajikar would have been to provide “a new type of asset security and wireless tracking system for electronic devices such as portable computers...to provide access control, tracking and security services of varying complexity without any additional hardware overheads,” as taught by Bajikar at paragraph 0007. But Bajikar already teaches a new type of asset security and wireless tracking system for electronic devices such as portable computers...to provide access control, tracking and security services of varying complexity without any additional hardware overheads (*see* paragraph 0007 of Bajikar). Thus, a person of ordinary skill in the art at the time of the invention clearly would not have found it necessary to combine Bajikar with AAPA and Harada in order to provide “a new type of asset security and wireless tracking system for electronic devices such as portable computers...to provide access control, tracking and security services of varying complexity without any additional hardware overheads.” Furthermore, the Examiner has failed to identify any reason as to why the teachings of AAPA and Harada would help to provide “a new type of asset security and wireless tracking system for electronic devices such as portable computers...to provide access control, tracking and security services of varying complexity without any additional hardware overheads.” Applicant respectfully submits that no such reason would have been apparent to a person of ordinary skill in the art at the time of the invention.

Accordingly, Applicant respectfully submits that an apparent reason to modify the references in the manner claimed by the Examiner is simply not present in the cited references, and thus the claims are not obvious over the cited combination of references.

For at least the above reasons, Applicant respectfully submits that claims 4, 6, 12, 16, 18, 22, 24, 28, 30, 34, 36, 40, 42, 46, 48, 52, 54, 58, 60, 64, 66, 70 and 72 are patentable over AAPA, Harada, and Bajikar.

V. Statement of Substance of Interview

Applicant thanks the Examiner for a courteous personal interview on February 19, 2008. The PTO-413 requires Applicant to file a Statement of Substance of Interview. The Statement of Substance of Interview is as follows:

The Examiner suggested amendments that may overcome the 35 U.S.C. § 112, first and second paragraph rejections.

Agreement was not reached with respect to the rejections under 35 U.S.C. § 103(a).

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Eric S. Barr/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Eric S. Barr
Registration No. 60,150

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